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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER SMITH, TERRI L	
			ART UNIT 3762	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,873

Applicant(s)

MO, SEUNG-KEE

Examiner

Terri L. Smith

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1-20-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the conductive member and the connection member (Figs. 5A and 5B, page 12, lines 17–19) and a lead terminal or an extruded terminal (Fig. 5A and 5B, page 13, line 1, respectively) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: On pages 10–12 the same parts are designated with different reference characters: conductive members are designated with reference characters 21 and 61, and the main bodies with reference characters 23a, 23b and 63. Appropriate correction is required.

On page 12 in line 15, the portion of the sentence that reads “and a conductive member 21 each other will be described” is unclear. It appears that some words may be missing from the sentence. Similarly, in line 17, the portion of the sentence that reads “Figs. 5A and 5B are views the method of connecting” is unclear for the same reasons as stated herein above.

3. The use of the trademark Velcro™ (e.g., on pages 4, 6, 10, 12 and 14) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Objections

4. Claim 11 is objected to because of the following informalities: The phrase “said connecting section said the conductive member are connected each other” is not clear. It appears that some additional words should be added to phrase to make it clear. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3762

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Applicant regards as his invention.

6. Claims 14 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 14 and 22 contain the trademark/trade name Velcro. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a means for adjusting a size of a circumference and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3762

8. Claims 1–6, 8–24 and 26–28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stein, U.S. Patent 5,814,093.

9. Regarding claims 1–6 and 15–20, Stein discloses a measuring and stimulating device (e.g., FIGS. 1–4); a main body (e.g., element 2); at least two conductive members (e.g., elements 9, 10 and 11); a connecting section (e.g. elements L1 and L2); and a control unit (elements 19 and 20 comprise the control circuit means (column 5, lines 16–17); column 7, line 50–column 9, line 26 teach ON/OFF thresholds/signals (optimizing parameters) which Examiner interprets as the limitation of a test electrical signal).

10. With respect to claims 8, 14, 21 and 22, Stein discloses cloth (claims 8 and 21) (e.g., column 4, lines 26–27) and Velcro (claims 14 and 22) (e.g., element 4).

11. Regarding claims 9 and 26, Stein discloses a plus or a minus polarity (e.g., elements 25, 30, 31 and 32, potentiometers).

12. With respect to claims 10 and 27, it is inherent that the other end of a conductive member in Stein is insulated to prevent the leads from shorting with the metal plate (e.g., element 7) to which they are attached.

13. Regarding claims 11 and 28, Stein discloses a connection member (e.g., elements L3–L7).

14. With respect to claims 12, 13, 23 and 24, Stein discloses a plurality of grooves (claims 12 and 23) (e.g., column 4, lines 54–57, where Webster's Dictionary March 1998 defines a groove as a long hollow such as may be formed by cutting and wherein it is the Examiner's position that the holes formed in the band of Stein reads on the claimed limitation of grooves) and height of conductive member is greater than depth of a groove (e.g., elements 9 and 10).

Art Unit: 3762

15. Claims 1–6, 9, 11–20, 22–24, 26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado, U.S. Patent 6,341,237.

16. Regarding claims 1–6, 9, 11, 15–20, 26 and 28 Hurtado discloses a measuring and stimulating device (e.g., FIGS. 1–6, 9 and 13–21; column 10, lines 1–11 where it is the Examiner's position that the stimulation signal delivered to the electrode meets the claimed limitation of the test electrical signal which is adjusted by the individual potentiometers which read on the claimed limitation of receiving a measured electrical signal); a main body (e.g., elements 24, 124, 326 and 423); at least two conductive members (e.g., elements 22 and 429); a connecting section (e.g. elements 36 and 433); and a control unit (e.g., elements 32, 504, 131–133, 135, 136, 404 and 428).

17. With respect to claims 12, 13, 23 and 24, Hurtado discloses a plurality of grooves and height of a conductive member is greater than depth of a groove (e.g., Fig. 19, the unhatched spaces shown beneath elements 429 represent the grooves).

18. Regarding claims 14 and 22, Hurtado discloses Velcro (e.g., column 4, lines 1–3).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein, U.S. Patent 5,814,093 or Hurtado, U.S. Patent 6,341,237.

21. Stein discloses the essential features of the claimed invention as described above except for conductive material includes at least any one of silicon, rag, cloth and leather having electrical conductivity. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use conductive material that includes at least any one of silicon, rag, cloth and leather having electrical conductivity, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

22. Additionally, it is well known in the art to use conductive material that includes at least any one of silicon, rag, cloth and leather having electrical conductivity to provide comfortable electrodes that, during use, are easy to handle and manipulate. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the inventions of Stein or Hurtado to use conductive material that includes at least any one of silicon, rag, cloth and leather having electrical conductivity to provide comfortable electrodes that, during use, are easy to handle and manipulate.

23. Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtado, U.S. Patent 6,341,237.

24. Hurtado discloses the essential features of the claimed invention as described above except for non-conductive material includes at least any one of silicon, rag, cloth and leather having electrical non-conductivity. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-conductive material that includes at least any one of silicon, rag, cloth and leather having electrical non-conductivity, since it has been

Art Unit: 3762

held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

25. Additionally, it is well known in the art to use conductive material that includes at least any one of silicon, rag, cloth and leather having electrical non-conductivity to provide comfortable electrodes that are easy to handle and manipulate during use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Hurtado to use non-conductive material that includes at least any one of silicon, rag, cloth and leather having electrical non-conductivity to provide comfortable electrodes that are easy to handle and manipulate during use.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terri L. Smith whose telephone number is (571) 272-7146. The Examiner can normally be reached on 7:30 a.m. - 4:30 p.m..

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3762


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TLS

June 5, 2007

5 June 2007



GEORGE R. EVANISKO
PRIMARY EXAMINER

6/7/7